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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Appellant: Gorkam I. Ates

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Washington, D.C. 20231

Date: Feb. 10, 2003

17

BRIEF ON APPEAL

18

Sir:

19

Appellant appeals from the final rejection of pending claims 1-6 and

20

files the instant Brief on Appeal in triplicate. Accordingly attached

21

herewith please find Agent's Check No.: 7078 drawn on CHEMICAL BANK in the

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amount of \$160.00 to cover the required fee for submission of applicant's

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brief on appeal for a small entity.

24

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RESPECTFULLY SUBMITTED

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1           Precedent is the soul of common law. It exists as folk law, passed  
2 on from written decision to written decision, much as our tribal ancestors  
3 passed on knowledge by word of mouth. It is this decisional law that  
4 appellant relies upon in support of his arguments presented, *infra*, in the  
5 instant Brief On Appeal.

1

## PRELUDE

2           The present invention is a system and method for allowing TCP/IP  
3 servers to assign jobs to other servers dynamically without relocating the  
4 client using neither HTTP nor HTML commands, wherein the "main server" is  
5 the server of the ISP (the main TCP/IP server), the "participants" are the  
6 servers that are assigned jobs, and the "client" is the client computer  
7 that makes the actual request. The system and method of the present  
8 invention depend upon the publicly known technique of "IP Spoofing" and  
9 take the relocating process away from the top networking OSI layers, such  
10 as TCP, HTTP and application level to the 3rd level of internetworking OSI  
11 that is the IP. It enables Internet-wide load balancing and content  
12 delivery with only a single IP involved as the listener.

13           In practice, the client requests a file or document from the main  
14 server (a streaming video and/or audio file is typical).

15           The main server operates at the firewall/IP level and has an IP  
16 stack (separate from the TCP/IP stack of the operating system) that can  
17 forward packets to another host with a TCP/IP connection and a basic  
18 database running that stores and retrieves the data of IP addresses and  
19 the ports of the participant servers and the socket information (IP, port,  
20 latest sequence number of the packet exchange as well as the TCP state) of  
21 the client. The main server examines the client's IP address and seeks  
22 the nearest participant server (the one that has the most bandwidth and  
23 CPU, geographically closest, and other serving requirements needed to  
24 serve a document to the client).

25           The main server, acting like an orchestra chief, requests the  
26 participant to send the document client requested to the client packet-by-  
27 packet, labeling each packet with the senders IP address being the main  
28 servers IP address. This enables the client, which has a port open only  
29 for a main server's address to accept the packets (the file). To

1 accomplish this goal, the main server examines the IP address port of the  
2 packet. Then takes action as:

- 3 1. if the port of the specific client's socket does not have a  
4 correspondence in the database (determined after a "SELECT" SQL  
5 statement), which means that the client has just started a  
6 connection with a SYN packet. Then this client socket is stored in  
7 the database with four variables: IP address, port number, and TCP  
8 state along with a timestamp for the socket; and
- 9 2. if the IP and port are present in the database as an active  
10 connection (a connection that is transferring data or in a wait  
11 state but not terminated), then the timestamp of the socket is  
12 updated with the current time of the arrival of the latest packet.  
13 The purpose of the timestamp is for a background thread in the main  
14 server to clean the obsolete (closed) socket entries in the database. The  
15 background thread does this by subtracting the timestamp from the current  
16 time and comparing this value with a defined (by the main server  
17 programmer or administrator) timeout value. If the timeout value is  
18 exceeded then the database entry is deleted. This means that the socket is  
19 indeed broken.

20 After that, the packet is modified. The source IP and port of the  
21 packet are preserved. The destination IP and port of the packet are  
22 changed to the listening IP and the port of the participant is selected as  
23 being geographically closest and with the best free resources in terms of  
24 CPU usage, volatile and non-volatile memory, and bandwidth.

25 The participant server processes the request as if it was directly  
26 requested by the client since the participant does not know from the IP  
27 packet that it was routed from the main server and thinks that the packet  
28 actually comes from the client since the packet has the source IP of the  
29 client. The participant sends the requested object with the sender's  
30 address (source IP) of the main server's IP address at the IP level. This

1 may require root privileges under Linux. Other requirements may apply to  
2 other systems.

3 When the client makes another request using the main server's IP  
4 address, the client requesting packages are routed to the main server, NOT  
5 to the participant server. This is the "normal behavior" of today's  
6 networking equipment (i.e. routers) and software.

7 In live stream and the participant does not have the file requested,  
8 than the file is first downloaded to the participant and then sent to the  
9 clients. In the lack of multicasting this will distribute the load of the  
10 main server to the participant servers and thus would save costs because  
11 adding participant servers would be relatively easy and cheap to add than  
12 clustering more servers to the main server.

13 The present invention:

- 14 1. Provides the advantages of multicasting such as low server and  
15 bandwidth costs but without multicasting supporting hardware.
- 16 2. Is fast and flexible - the number of participants can be changed  
17 dynamically with little cost compared to upgrading the main server.
- 18 3. Is not difficult to implement.
- 19 4. Relies on the fact that multicasting equipment is expensive and  
20 ISP's are reluctant to upgrade and unless most of the net is  
21 equipped with multicasting machines, multicasting won't operate  
22 efficiently.
- 23 5. Participants are safe in the network against attacks such as denial  
24 of service attacks because their IP addresses are not revealed to  
25 the clients, and thus hackers.

26 In operation, a main server is established. A participant Internet  
27 surfer enters username, password, and other necessary information required  
28 for financial processing to a form in a web page of the website of the  
29 present invention. When a participant user decides to become active in  
30 the system, it will surf to the website and enter his username, password.  
31 The participant's computer will then load an applet (possibly written in

1     ActiveX or Java in 1999 terms) that will be the server software of the  
2     "participant" (participant is the participating web surfer or company  
3     computer).     The applet will first calculate the participants CPU,  
4     bandwidth, and memory power (and other necessary resources) and will start  
5     a timer for the participant to start serving under rule of the main  
6     server.     Information about the participant will be recorded on a database  
7     in the main server (main server may be any machine with at least one IP  
8     address connected to the Internet backbone).     When a web surfer requests  
9     a file, the main server will search through its database of servers and  
10    select the most appropriate server in terms of serving ability depending  
11    on its previous evaluation of participants.     The main server will command  
12    the participant, via the open listening socket of the applet loaded in the  
13    participant's machine, to serve the client.     When the participant server  
14    decides to go offline, the main server calculates the amount earned by the  
15    participant Internet user and records it.     At the end of a period,  
16    participant person will get his money by check.     The main server will have  
17    the computing power of the net efficiently, cheaply, and dynamically at  
18    its fingerprints.     The main server will be the powerhouse between ISPs.



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(1) REAL PARTY IN INTEREST

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The party identified in the caption of the instant brief is the real party in interest pursuant to 37 CFR 1.192(c)(1).

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(2) RELATED APPEALS AND INTERFERENCES

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There are no appeals or interferences known to applicant's legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in pending appeals pursuant to 37 CFR 1.192(c)(2).

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(3) STATUS OF CLAIMS

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Claims 1-6 now pending in the application have been finally rejected and are on appeal. No claims have been cancelled.

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(4) STATUS OF AMENDMENTS

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No amendment has filed subsequent to the final rejection.

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(5) SUMMARY OF INVENTION

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Claim 1, the only independent apparatus claim on files, defines:

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1. An Internet system (20)[Figure 2], comprising:
  - a) a main server (22) for storing information (24) to be requested over the Internet (26) by a client (28) so as to form a request for information (30) and having an IP address (32)[page 17, lines 2-8]; and

1           b)     at least one participant server (34) having an IP address (36)  
2                     and electrically communicating with said main server (22)[page  
3                     17, lines 9-11]; said at least one participant server (34) not  
4                     receiving the request for information (30) from the client  
5                     (28), but rather said main server (22) receiving the request  
6                     for information (30) over the Internet (26) from the client  
7                     (28) and requesting over the Internet (26) that said at least  
8                     one participant server (34) send the requested information  
9                     (30) over the Internet (26) back to the client (28)[page 17,  
10                    lines 12-17], and if said at least one participant server (34)  
11                    does not have the requested information (30), the requested  
12                    information (30) is downloaded from said main server (22) to  
13                    said at least one participant server (34)[page 17, lines 17-  
14                    21], and when said at least one participant server (34) sends  
15                    the requested information (24) over the Internet (26) back to  
16                    the client (28), said at least one participant server (34)  
17                    assigns to the requested information (24) said IP address (32)  
18                    of said main server (22) and not said IP address (36) of said  
19                    at least one participant server (34)[page 17, line 22 to page  
20                    18, line 2].

21           Claim 2, the first dependent apparatus claim on file, defines:

22       2.     The system as defined in claim 1, wherein said main server (22) is  
23               a TCP/IP server and assign jobs to said at least one participant  
24               server (34) dynamically without relocating the client (28) using  
25               neither HTTP nor HTML commands so as to take relocating process away  
26               from top networking OSI layers to 3rd level of Internet working OSI  
27               that is IP so as to enable starting downloading of the requested  
28               information (24) from one of said at least one participant servers  
29               (34) and finishing the downloading from another of said at least one

1 participant server (34) without ever noticing server alteration by  
2 virtue of said at least one participant server (34) assigning to the  
3 requested information (24) said IP address (32) of said main server  
4 (22) and not said IP address (36) of said at least one participant  
5 server (34)[page 18, lines 3-11].

6 Claim 3, the second dependent apparatus claim on file, defines:

7 3. The system as defined in claim 2, wherein said top networking OSI is  
8 at least one of TCP, HTTP, and application level [page 18, lines 12-  
9 12].

10 Claim 4, the only independent method claim on file, defines:

11 4. A method for using an Internet system (20), comprising the steps of  
12 [Figures 3A-3D]:  
13 a) making a request for information (30), over the Internet (26),  
14 by a client (28), to a main server (22) of the Internet system  
15 (20) and not to said at least one participant server (34)[page  
16 18, lines 17-19][Figure 3A];  
17 b) examining an IP address (38) of the client (28), by said main  
18 server (22)[page 18, lines 23-24][Figure 3A];  
19 c) seeking at least one participant server (34) of the Internet  
20 system (20), by said main server (22), so as to form an at  
21 least one nearest participant server (40)[page 18, lines 1-  
22 3][Figure 3B];  
23 d) requesting over the Internet (26), by said main server (22)  
24 acting like an orchestra leader, that said at least one  
25 nearest participant server (40) send the requested information  
26 (24) to the client (28), packet-by-packet, over the Internet  
27 (26)[page 19, lines 4-8][Figure 3B];

- 1 e) determining if said at least one nearest participant server  
2 (40) has the requested information (24)[page 19, lines 9-  
3 10][Figure 3B];
- 4 f) labeling, by said at least one nearest participant server  
5 (40), each packet with an IP address (32) of said main server  
6 (22), which enables the client (28) which has a port open only  
7 for main server addresses to accept said packets, if answer to  
8 step e) is yes [page 18, lines 11-15][Figure 3C];
- 9 g) sending the requested information (24) with said IP address  
10 (32) of said main server (22), by said at least one nearest  
11 participant server (40), to the client (28), over the Internet  
12 (26)[Figure 3D];
- 13 h) downloading the requested information (24) from said main  
14 server (22) to said at least one nearest participant server  
15 (40), which will distribute the load of said main server (22)  
16 to said at least one participant server (40) when lacking  
17 multicasting so as to save costs, by virtue of said at least  
18 one participant server (40) being relatively easy and  
19 inexpensive to add as compared to clustering more servers to  
20 said main server (22), if answer to STEP 5 is no [page 19,  
21 line 20 to page 20, line 3][Figure 3C]; and
- 22 i) returning to step f) [page 20, line 4][Figure 3C].

23 Claim 5, the first dependent method claim on file, defines:

- 24 5. The method as defined in claim 4, wherein said step of making a  
25 request for information (30), over the Internet (26), by the client  
26 (28), from the main server (22) includes making the request for at  
27 least one of a streaming video and an audio, over the Internet (26),  
28 by the client (28), from the main server (22)[page 20, lines 5-9].



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(8) ARGUMENT

2

ISSUE I

3

Whether claims 1 and 4 are unpatentable under 35 U.S.C. 103(a) over  
Brendel et al. in view of Bell et al.

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Appellant respectfully draws the Examiner's attention to the fact  
that the Federal Circuit holds that relevant case law must be relied upon  
in determining obviousness ipso facto the determination of obviousness is  
a matter of law, as was decided in In re Deuel, 51 F.3d 1552, 1557, 34  
USPQ.2d (BNA) 1210, 1214 (Fed. Cir. 1995), where the Court held:

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"Obviousness is a  
question of law, which  
we review de novo,  
though factual findings  
underlying the Board's  
o b v i o u s n e s s  
determination are  
reviewed for clear  
error. In re Vaack,  
947 F.2d 488, 493, 20  
USPQ2d 1438, 1442 (Fed.  
Cir. 1991); In re  
Woodruff, 919 F.2d 1575,  
1577, 16 USPQ2d 1934,  
1935 (Fed. Cir. 1990)."  
[at 1214][Emphasis  
added]

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And, in Richardson-Vicks Inc. v. The Upjohn Co., 122 F.3d 1476, 44  
USPQ.2d 1181 (Fed. Cir. 1997), where the Court held:

"The difficulty with  
RVI's position is that,  
although the argument  
has merit when the issue  
is purely one of fact,  
it does not follow when  
the issue involves a  
question of law. It is  
black letter law that

1 the ultimate question of  
2 obviousness is a  
3 question of law. "See  
4 Graham v. Deere Co., 383  
5 U.S. 1, 17, 148 USPQ  
6 459, 467 (1966) (citing  
7 Great A. & P. Tea Co. v.  
8 Supermarket Equip. Co.,  
9 340 U.S. 147, 155, 87  
10 USPQ 303, 309 (1950));  
11 In re Donaldson Co., 16  
12 F.3d 1189, 1192, 29  
13 USPQ2d 1845, 1848 (Fed.  
14 Cir. 1994) (en banc);  
15 Texas Instruments Inc.  
16 v. Unit States Int'l  
17 Trade Comm'n, 988 F.2d  
18 1165, 1178, 26 USPQ2d  
19 1018, 1028 (Fed. Cir.  
20 1993). And we review  
21 that legal question  
22 without deference to the  
23 trial court. See  
24 Gardner V. TEC Sys.  
25 Inc., 725 F.2d 1338,  
26 1344, 220 USPQ 777, 782  
27 (Fed. Cir. 1984)  
28 (district court's  
29 conclusion on  
30 obviousness "is one of  
31 law and subject to full  
32 and independent review  
33 in this court"). "[at  
34 1183][Emphasis added]

35 In the seminal case of Graham v. John Deere Co., 383 U.S. 1, 17, 148  
36 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684 (1966), the Supreme Court  
37 articulated the requirements for a prima facie holding of obviousness.  
38 The Patent Office has since set forth in MPEP 706.02 a three step  
39 requirement for establishing a prima facie case of obviousness.

40 The first step requires that the Examiner must set forth the  
41 differences in the claim over the applied references. The second step  
42 requires that the Examiner must set forth the proposed modification of the

1 reference which would be necessary to arrive at the claimed subject  
2 matter. And, the third step requires that the Examiner must explain why  
3 the proposed modification would be obvious.

4 The Courts require that in order to satisfy the third step for  
5 establishing a prima facie case of obviousness, the Examiner must identify  
6 where the prior art provides a motivating suggestion to make the  
7 modifications proposed in the second step for establishing a prima facie  
8 case of obviousness, as was expressed in the 1992 Federal Circuit Court  
9 decision in In re Jones, 958, F.2d 347, 21 USPQ.2d 1941, where the Court  
10 held:

11 "Contention that one  
12 skilled in the  
13 herbicidal art would  
14 have been motivated to  
15 use, with acid commonly  
16 known as "dicamba,"  
17 substituted ammonium  
18 salt such as that  
19 disclosed in two prior  
20 references does not  
21 warrant holding that  
22 claimed substituted  
23 ammonium salt of dicamba  
24 for use as herbicide is  
25 prima facie obvious,  
26 since there is no  
27 suggestion for combining  
28 disclosures of those  
29 references either in  
30 references themselves,  
31 which are directed to  
32 shampoo additives and  
33 production of  
34 m o r p h o l i n e ,  
35 respectively, or in  
36 knowledge generally  
37 available to those  
38 skilled in the art."[at  
39 1941][Emphasis added]



1 "The Solicitor points  
2 out that, given the  
3 breadth of forms of  
4 dicamba (free acid,  
5 ester, or salt)  
6 disclosed by Richter as  
7 having herbicidal  
8 utility, one of ordinary  
9 skill in the art would  
10 appreciate that the  
11 dicamba group has  
12 significance with  
13 respect to imparting  
14 herbicidal activity to  
15 dicamba compounds.  
16 Thus, the solicitor  
17 contends, one skilled in  
18 the art would have been  
19 motivated to uses, with  
20 dicamba, substituted  
21 ammonium salts made from  
22 a known amine, such as  
23 the amine disclosed by  
24 Zorayan and Wideman, and  
25 would have expected such  
26 a salt to have  
27 herbicidal activity.  
28 Before the PTO may  
29 combine the disclosures  
30 of two or more prior art  
31 references in order to  
32 establish prima facie  
33 obviousness, there must  
34 be some suggestion for  
35 doing so, found either  
36 in the references  
37 themselves or in the  
38 knowledge generally  
39 available to one of  
40 ordinary skill in the  
41 art." In re Fine, 837  
42 F.2d 1071, 1074, 5  
43 USPQ2d 1596, 1598-99  
44 (Fed. Cir. 1988). We  
45 see no such suggestion  
46 in Zorayan, which is

1 directed to shampoo  
2 additives, nor Wideman,  
3 which teaches that the  
4 amine used to make the  
5 claimed compound is a  
6 byproduct of the  
7 production of  
8 morpholine. Nor does  
9 the board disclosure of  
10 Richter fill the gap,  
11 for the reasons  
12 discussed above."[at  
13 1943][Emphasis added]

14 And, in Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 912 F.Supp.  
15 422, 38 USPQ.2d 1300 (W.D.Ark. 1996), where the Court held:

16 "The existence of  
17 separate elements of the  
18 invention in the prior  
19 art is insufficient to  
20 establish obviousness,  
21 absent some teaching or  
22 suggestion in the prior  
23 art to combine the  
24 elements." [Emphasis  
25 added]

26 And, in Gambro Lundia AB v. Baxter Healthcare Corporation, 110 F.3d  
27 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997), where the court held:

28 "Without a suggestion or  
29 teaching to combine, a  
30 case of obviousness is  
31 deficient." [Emphasis  
32 added]

33 The Courts further require, however, that even if the prior art may  
34 be modified as suggested by the Examiner, the modification is not made  
35 obvious unless the prior art suggests the desirability of the  
36 modification, as was expressed in the 1992 Federal Circuit Court decision  
37 in In re Fritch, 922, F.2d 1260, 23 USPQ.2d 1780, where the Court held:

38 "Mere fact that prior  
39 art may be modified to  
40 reflect features of

1 claimed invention does  
2 not make modification,  
3 and hence claimed  
4 invention, obvious  
5 unless desirability of  
6 such modification is  
7 suggested by prior art  
8 ...."[at 1780][Emphasis  
9 added]

10 "The mere fact that the  
11 prior art may be  
12 modified in the manner  
13 suggested by the  
14 Examiner does not make  
15 the modification obvious  
16 unless the prior art  
17 suggested the  
18 desirability of the  
19 modification. In re  
20 Gordon, 733 F.2d at 902,  
21 221 USPQ at 1127."[at  
22 1783][Emphasis added]

23 And further, the Fritch Court at 1783, held that the patent  
24 applicant may attack the Examiner's prima facie determination as  
25 improperly made out and tending to support a conclusion of nonobviousness:

26 "In proceedings before  
27 the Patent and Trademark  
28 Office, the Examiner  
29 bears the burden of  
30 establishing a prima  
31 facie case of  
32 obviousness based upon  
33 the prior art...[The  
34 Examiner] can satisfy  
35 this burden only by  
36 showing some objective  
37 teaching in the prior  
38 art or that knowledge  
39 generally available to  
40 one of ordinary skill in  
41 the art would lead to  
42 that individual to  
43 combine the relevant

1 teachings of the  
2 references. The patent  
3 applicant may then  
4 attack the Examiner's  
5 p r i m a f a c i e  
6 determination as  
7 improperly made out, or  
8 the applicant may  
9 present objective  
10 evidence tending to  
11 support a conclusion of  
12 nonobviousness."  
13 [Emphasis added]

14 In this same regard, the Examiner's attention is respectfully drawn  
15 to the decisions in Heidelberger Druckmaschinen AG v. Hantscho Commercial  
16 Products, Inc., 21 F.3d 1068, 30 USPQ.2d 1377; In re Fine, 837 F.2d 1071,  
17 5 USPQ.2d 1596 (Fed. Cir. 1988); In re Keller, 642 F.2d 413, 208 USPQ 871  
18 (CCPA 1981); and In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375  
19 (Fed. Cir. 1986).

20 In properly applying the Graham v. John Deere Co. test in light of,  
21 inter alia, In re Jones, and In re Fritch discussed supra, the Examiner  
22 must conduct a rigorous examination and analysis of the prior art. It  
23 would appear that the Examiner has not done so.

24 Neither Brendel et al., Bell et al., nor for that matter any of the  
25 references cited by the Examiner, make any motivating suggestion that,  
26 inter alia the system of Brendel et al. can be modified to have its  
27 outgoing address replaced by the outgoing address of Bell et al., as  
28 suggested by the Examiner.

29 The Examiner has merely combined elements in a piecemeal manner in  
30 light of appellant's disclosure to show obviousness by using appellant's  
31 own specification as though it were prior art and in doing so has violated  
32 the basic mandate inherent in 35 U.S.C. 103, as was decided in In re Kamm  
33 and Young, 17 USPQ 298 ff, where the Court held:

34 "The rejection here runs  
35 afoul of a basic mandate

1 inherent in section 103  
2 - that a piecemeal  
3 reconstruction of the  
4 prior art patents in the  
5 light of appellants'  
6 disclosure shall not be  
7 the basis for a holding  
8 of obviousness."  
9 [Emphasis added]

10 And, in In re Stephens, Wenzl, and Browne, 145 USPQ 656 (CCPA 1965),  
11 where the Court reversed a rejection on a combination of references and  
12 held:

13 "References may not be  
14 c o m b i n e d  
15 indiscriminately and  
16 with guidance from  
17 applicant's disclosure  
18 to show that the claims  
19 are unpatentable."[at  
20 656][Emphasis added]

21 "In our consideration of  
22 the record in light of  
23 appellants' arguments,  
24 we find nothing which  
25 demonstrates that the  
26 examiner and the board  
27 erred in rejecting the  
28 claims. While we agree  
29 with appellants that  
30 references may not be  
31 c o m b i n e d  
32 indiscriminately and  
33 with guidance from  
34 appellants' disclosure  
35 to show that claims are  
36 unpatentable, we think  
37 the combination of  
38 references her is proper  
39 and adequately suggests  
40 the structure appellants  
41 have achieved."[at 657]  
42 [Emphasis added]

1 And, in Panduit Corp. v. Burndy Corporation et al., 180 USPQ 498  
2 (District Court, N.D. Illinois, E. Div.), where the Court held:

3 "Inquiry into the  
4 patentability must be  
5 directed toward subject  
6 matter as a whole and  
7 not to elements of a  
8 combination and their  
9 individual novelty;  
10 combination which  
11 results in a more  
12 facile, economical, or  
13 efficient unit, or which  
14 provides results  
15 unachieved by prior art  
16 structures, cannot be  
17 anticipated piecemeal by  
18 showing that elements  
19 are individually old."  
20 [at 498][Emphasis added]

21 "The inquiry into the  
22 patentability must be  
23 directed toward the  
24 subject matter as a  
25 whole and not to the  
26 elements of the claimed  
27 combination and their  
28 individual novelty, and  
29 therefore a patented  
30 combination which  
31 results in a more  
32 facile, economical or  
33 efficient unit, or which  
34 provides results  
35 unachieved by prior art  
36 structures, cannot be  
37 anticipated piecemeal by  
38 showing that the various  
39 elements of the  
40 invention are  
41 individually old.  
42 The difference between  
43 the subject matter set  
44 forth in the Re. 26,492

1 patent and the subject  
2 matter of the cited  
3 prior art references as  
4 a whole would not have  
5 been obvious at the time  
6 the invention was made  
7 to a person of ordinary  
8 skill in the art to  
9 which such subject  
10 matter pertains, under  
11 35 U.S.C. 103.[at 505]  
12 [Emphasis added]

13 And, in Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d  
14 877, 45 USPQ.2d 1977 (Fed. Cir. 1998), where the Court held:

15 "Federal district  
16 court's formulation of  
17 problem confronting  
18 inventors of needles for  
19 automatic knitting  
20 machine presumes their  
21 solution to problem,  
22 namely modification of  
23 "stem segment" of  
24 needles; defining  
25 problem in terms of its  
26 solution reveals  
27 improper hindsight in  
28 selection of prior art  
29 relevant to obviousness,  
30 resulted in district  
31 court adopting overly  
32 narrow view of scope of  
33 prior art, and infected  
34 district court's  
35 determinations about  
36 content of prior art."  
37 [at 1978][Emphasis  
38 added]

39 "To ascertain the scope  
40 of the prior art, a  
41 court examines "the  
42 field of the inventor's  
43 endeavor," Shatterproof

1 Glass Corp. v. Libbey-  
2 Owens Ford Co., 758 F.2d  
3 613, 620, 225 USPQ 634,  
4 628 (Fed. Cir. 1985),  
5 and "the particular  
6 problem with which the  
7 inventor was involved,"  
8 Stratoflex, Inc. v.  
9 Aerquip Corp., 713 F.2d  
10 1530, 1535, 218 USPQ  
11 871, 876 (Fed. Cir.  
12 1983) (quoting In re  
13 Wood 599 F.2d 1032,  
14 1036, 202 USPQ 171, 174  
15 (CCPA 1979)), at the  
16 "time the invention was  
17 made," see 35 U.S.C. 8  
18 103(a). The district  
19 court defined the  
20 problem as "designing  
21 the stem segment of a  
22 knitting needle...[to]  
23 minimize[] needle head  
24 breakage and thus  
25 maximize[] the operating  
26 speed of an industrial  
27 knitting machine."  
28 (emphasis added). The  
29 '053 patent, on the  
30 other hand, describes  
31 the inventor's problem  
32 as "providing [knitting  
33 needles] with a means  
34 which avoids head  
35 breakages or lets  
36 [breakages] start to an  
37 extent worth mentioning  
38 only at higher knitting  
39 speeds." '053 patent,  
40 col. 1, lines 48-51.  
41 The district court's  
42 formulation of the  
43 problem confronting the  
44 '053 inventors presumes  
45 the solution to the  
46 problem - modification



1 of the stem segment.  
2 defining the problem in  
3 terms of its solution  
4 reveals improper  
5 hindsight in the  
6 selection of the prior  
7 art relevant to  
8 obviousness. See, e.g.  
9 In re Antle, 444 F.2d  
10 1168, 1171-72, 170 USPQ  
11 285, 287-88 (CCPA 1971)  
12 (warning against  
13 selection of prior art  
14 with hindsight). By  
15 importing the ultimate  
16 solution into the  
17 problem facing the  
18 inventors, the district  
19 court adopted an overly  
20 narrow view of the scope  
21 of the prior art. It  
22 also infected the  
23 district court's  
24 determinations about the  
25 content of the prior  
26 art."[at 1981][Emphasis  
27 added]

28 And, in In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir.  
29 1998), where the Court reversed the Board's decision in which the level of  
30 skill in the art being high was not sufficient to supply motivation:

31 "Three possible sources  
32 for motivation to  
33 combine prior art  
34 references in manner  
35 that would render  
36 claimed invention  
37 obvious are nature of  
38 problem to be solved,  
39 teachings of prior art,  
40 and knowledge of persons  
41 of ordinary skill in  
42 art; high level of skill  
43 in field of art cannot  
44 be relied upon to

1 provide necessary  
2 motivation absent  
3 explanation of what  
4 specific understanding  
5 or technical principle,  
6 within knowledge one of  
7 ordinary skill in art,  
8 would have suggested  
9 combination, since if  
10 such rote invocation  
11 could suffice to supply  
12 motivation to combine,  
13 more sophisticated  
14 scientific fields would  
15 rarely, if ever,  
16 experience patentable  
17 technical advance."[at  
18 1453][Emphasis added]

19 "Claimed low orbit  
20 satellite communication  
21 system for mobile  
22 terminals is not prima  
23 facie obvious over  
24 combination of two prior  
25 art references, even  
26 though person possessing  
27 high level of skill  
28 characteristic of this  
29 field would know to  
30 account for differences  
31 between claimed  
32 invention and prior art  
33 combination, since high  
34 level of skill in art,  
35 without more, cannot  
36 supply required  
37 motivation to combine  
38 references, and does not  
39 overcome absence of any  
40 actual suggestion to  
41 combine; obviousness  
42 rejection will not be  
43 upheld, even where skill  
44 in art is high, absent  
45 specific identification

1 of principle, known to  
2 one of ordinary skill,  
3 that suggests claimed  
4 combination."[at 1454]  
5 [Emphasis added]

6 Furthermore, pursuant to 37 CFR 1.111(c), claims 1 and 4 define the  
7 following advantageous distinctive features, that distinguish over, and  
8 avoid, the prior art:

- 9 a) "...said main server...  
10 requesting over the  
11 Internet that said at  
12 least one participant  
13 server send the  
14 requested information  
15 over the Internet back  
16 to the client..."[claim  
17 1][Emphasis added];
- 18 b) "...if said at least one  
19 participant server does  
20 not have the requested  
21 information, the  
22 requested information is  
23 downloaded from said  
24 main server to said at  
25 least one participant  
26 server..."[claim 1]  
27 [Emphasis added];
- 28 c) "requesting over the  
29 Internet, by said main  
30 server acting like an  
31 orchestra leader, that  
32 said at least one  
33 nearest participant  
34 server send the  
35 requested information  
36 over the Internet back  
37 to the client..."[claim  
38 4][Emphasis added]; and
- 39 d) "downloading the  
40 requested information  
41 from said main server to

1                   said at least one  
2                   nearest participant  
3                   server..."[claim 4]  
4                   [Emphasis added].

5           It was decided in In re Miller, 169 USPQ 597 (CCPA 1971) that each  
6   and every limitation, inter alia those discussed supra, must be met in  
7   determining patentability:

8                   "All words in a claim  
9                   must be considered in  
10                  j u d g i n g   t h e  
11                  patentability of that  
12                  claim against the prior  
13                  art."[at 600][Emphasis  
14                  added]

15           In this same regard, the Examiner's attention is respectfully  
16   directed to the decisions in In re Fuetterer, 138 USPQ 217 (CCPA 1963);  
17   and In re Ludke and Sloan, 169 USPQ 563 (CCPA 1971).

18           When the Internet system of the present invention is designed in  
19   accordance with the advantageous distinctive features of claims 1 and 4  
20   discussed supra, inter alia:

- 21   1.   The at least one participant server can be located anywhere in the  
22       world regardless of where in the world the main server is located  
23       ipso facto "...said main server... requesting over the Internet that  
24       said at least one participant server send the requested information  
25       over the Internet back to the client..."[claim 1][Emphasis added]  
26       and "requesting over the Internet, by said main server acting like  
27       an orchestra leader, that said at least one nearest participant  
28       server send the requested information over the Internet back to the  
29       client..."[claim 4][Emphasis added], as opposed to the main server  
30       communicating with the at least one participant server over a  
31       discrete and/or distinct and/or dedicated connection.
- 32   2.   Costly multicasting [the at least one participant server is  
33       relatively easy and inexpensive to add as compared to clustering  
34       more servers to the main server] is not required if the at least one

1 participant server does not contain the requested information ipso  
2 facto "...if said at least one participant server does not have the  
3 requested information, the requested information is downloaded from  
4 said main server to said at least one participant server..."[claim  
5 1][Emphasis added] and "downloading the requested information from  
6 said main server to said at least one nearest participant server..."  
7 [claim 4][Emphasis added].

8 Even though the advantageous features of the present invention  
9 discussed supra may not have been disclosed and discussed specifically in  
10 the specification of the patent application as it was originally filed,  
11 they still must be relied upon as evidence of patentability, as was  
12 decided in In re Chu, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995), where  
13 the Court held:

14 "Board of Patent Appeals  
15 and Interferences erred,  
16 in upholding obviousness  
17 rejection of applicant's  
18 claims, by concluding  
19 that claims' disclosure  
20 was matter of "design  
21 choice," and that the  
22 applicant's evidence and  
23 arguments to contrary  
24 are not present in  
25 specification and are  
26 therefore unpersuasive,  
27 since board is required  
28 to consider totality of  
29 record and is not free  
30 to disregard evidence  
31 and arguments presented  
32 by applicants, and since  
33 there is no support for  
34 proposition that  
35 evidence and/or  
36 arguments traversing 35  
37 USC 103 rejection must  
38 be contained within  
39 specification, given

1 that obviousness is  
2 determined by totality  
3 of record including, in  
4 some instances most  
5 significantly, evidence  
6 and arguments proffered  
7 during give-and-take of  
8 ex parte patent  
9 prosecution."[at 1090]  
10 [Emphasis added]

11 "Because the Board was  
12 required to consider the  
13 totality of the record,  
14 the Board was not free  
15 to disregard the  
16 evidence and arguments  
17 presented by Chu in  
18 response to the  
19 obviousness rejection.  
20 Additionally, the Board  
21 erred in apparently  
22 requiring Chu's evidence  
23 and arguments responsive  
24 to the obviousness  
25 rejection to be within  
26 his specification in  
27 order to be considered.  
28 To require Chu to  
29 include evidence and  
30 arguments in the  
31 specification regarding  
32 whether placement of the  
33 SCR catalyst in the bag  
34 retainer was a matter of  
35 "design choice" would be  
36 to require patent  
37 applicants to divine the  
38 rejections the PTO will  
39 proffer when patent  
40 applications are filed."  
41 [at 1094][Emphasis  
42 added]

43 "We have found no cases  
44 supporting the position

1                   that a patent  
2                   applicant's evidence  
3                   and/or arguments  
4                   traversing a 8 103  
5                   rejection must be  
6                   contained within the  
7                   specification. There is  
8                   no logical support for  
9                   such a proposition as  
10                  well, given that  
11                  obviousness is  
12                  determined by the  
13                  totality of the record  
14                  including, in some  
15                  instances, most  
16                  significantly, the  
17                  evidence and arguments  
18                  proffered during the  
19                  give-and-take of ex  
20                  parte patent  
21                  prosecution."[at 1095]  
22                  [Emphasis added]

23                  And, even though the present invention may be considered simple and  
24                  accomplishes only a small but genuine improvement by some is not  
25                  sufficient reason to deny it patent protection, as was decided in Schnell  
26                  et al. v. The Allbright-Nell Company et al., 146 USPQ 322 (Court of  
27                  Appeals, Seventh Circuit 1965), where the Court held:

28                         "Device seems simple and  
29                         obvious in light of  
30                         patentee's teaching, but  
31                         it evidently was not  
32                         obvious at time of  
33                         invention; those working  
34                         in the field did not  
35                         accomplish patentee's  
36                         results; that fact  
37                         supports conclusion that  
38                         patentee achieved  
39                         patentable invention."  
40                         [at 322][Emphasis added]

41                         "This now seems simple  
42                         and obvious in the light

1 of the Schnell teaching,  
2 but is was evidently not  
3 at all obvious at the  
4 time of the invention.  
5 Those working in the  
6 field did not accomplish  
7 Schnell's results. That  
8 fact supports the  
9 conclusion that Schnell  
10 achieved patentable  
11 inventions. Pyle Nat.  
12 Co. v. Lewin, 7 Cir.,  
13 1937, 92 F.2d 628, 630,  
14 35 USPQ 40, 42."[at 324]  
15 [Emphasis added]

16 The Board of Appeals expressed the same concept when it held in Ex  
17 parte Grasenick and Gessner, 158 USPQ 624 (Patent Office Board of Appeals  
18 1967), that:

19 "Improvement over prior  
20 art, even though it be  
21 simple or involves only  
22 a reversing of certain  
23 parts, is patentable  
24 unless prior art shows  
25 that improvement is  
26 obvious." [at 624]  
27 [Emphasis added]

28 "This rejection is in  
29 error. An improvement  
30 over the prior art, even  
31 though it be simple or  
32 involves only a  
33 reversing of certain  
34 parts, is patentable  
35 unless the prior art  
36 shows the improvement to  
37 be obvious. The  
38 examiner has neither  
39 cited evidence  
40 establishing the  
41 obviousness of  
42 appellant's modification  
43 of the prior art nor



1 demonstrated that the  
2 improved results claimed  
3 by appellants are not  
4 available from their  
5 construction."[at 624]  
6 [Emphasis added]

7 Attention is also respectfully directed in this regard to the  
8 decisions in Mercantile National Bank of Chicago et al v. Quest, Inc. et  
9 al. DC., N.D. Indiana, 166 USPQ 517; In re Shelby, 136 USPQ 220; and In re  
10 Irani and Moedritzer, 166 USPQ 24, which all indicate that simplicity does  
11 not operate as a bar to patentability if the invention was unobvious at  
12 the time it was made.

13 Turning now to the references, and with regard to advantageous  
14 distinctive features a) and c) of claims 1 and 4, respectively, discussed  
15 supra, contrary to the Examiner's statement made at page 4, paragraph 13,  
16 subparagraph 3, lines 3-6 of the Final Rejection, Brendel et al. does not  
17 teach "...said main server... requesting over the Internet that said at  
18 least one participant server send the requested information over the  
19 Internet back to the client..." [claim 1][Emphasis added] or "requesting  
20 over the Internet, by said main server acting like an orchestra leader,  
21 that said at least one nearest participant server send the requested  
22 information over the Internet back to the client..."[claim 4][Emphasis  
23 added], but rather teaches that the load balancer 70 (relied upon by the  
24 Examiner at page 4, paragraph 13, subparagraph 3, line 6 of the Final  
25 Rejection as the main server of the present invention) communicates with  
26 a server 52 (relied upon by the Examiner at page 4, paragraph 13,  
27 subparagraph 3, line 6 of the Final Rejection as the at least one  
28 participant server of the present invention) over the discrete and/or  
29 distinct and/or dedicated connection 120 that is independent of Internet  
30 66, as shown in figure 8 of Brendel et al. (relied upon by the Examiner).

31 With this arrangement of Brendel et al., the server 52 cannot be  
32 located anywhere in the world regardless of where in the world the load

1 balancer 70 is located ipso facto the load balancer 70 communicates with  
2 the server 52 over the discrete and/or distinct and/or dedicated  
3 connection 120.

4 Additionally, Brendel et al. disclose at col. 20, lines 34-37:

5 "The web farm has been  
6 described as having a  
7 "local" network, but  
8 this local network could  
9 be local only in the  
10 sense that it is not the  
11 Internet backbone."

12 Brendel et al. teach communicating between the scheduler and the  
13 server with a proprietary (OSI 3rd level) protocol called IXP.

14 In contradistinction, the present invention teaches communicating  
15 with the participants (the equivalent of web servers in Brendel et al.)  
16 from the main server (the scheduler) with the standard IP (Internet  
17 Protocol) protocol so that the present invention can reside where there is  
18 no specialized frame relay or ISDN or leased line communication between  
19 the scheduler and the participant and when there is only a standard  
20 Internet connection that is using the Internet backbone, which Brendel et  
21 al. simply cannot do.

22 With regard to advantageous distinctive features b) and d) of claims  
23 1 and 4, respectively, discussed supra, contrary to the Examiner's  
24 statement made at page 5, lines 6-8 of the Final Rejection, Brendel et al.  
25 does not teach "...if said at least one participant server does not have  
26 the requested information, the requested information is downloaded from  
27 said main server to said at least one participant server..."[claim 1]  
28 [Emphasis added] or "downloading the requested information from said main  
29 server to said at least one nearest participant server..."[claim 4]  
30 [Emphasis added], but rather teaches that the information downloaded from  
31 the load balancer 70 to the server 52 is not the requested information but  
32 rather is the browser's stored ACK packet, as shown in the middle of  
33 figure 11A of Brendel et al. where it is disclosed that ACK(0) is

1 forwarded from the load balancer 70 to the server connected to the client  
2 and as discussed at col. 12, lines 50-52 of Brendel et al. (relied upon by  
3 the Examiner at page 5, lines 8-9 of the Final Rejection), where it is  
4 disclosed:

5 "The load balancer then  
6 sends the browsers  
7 stored ACK packet to the  
8 assigned server...."  
9 [Emphasis added]

10 And, wherein the ACK(0) packet is an acknowledgment packet by the  
11 browser 10 to the load balancer 70, as discussed at col. 12, lines 17-19  
12 of Brendel et al., where it is disclosed:

13 "The load balancer  
14 replies with a SYN/ACK  
15 packet to the browser,  
16 and the browser replies  
17 with an acknowledgment  
18 packet, ACK(0)."  
19 [Emphasis added]

20 With this arrangement of Brendel et al., costly multicasting would  
21 be required if the servers other than that containing the load balancer  
22 did not contain the requested information.

23 As can be seen, Brendel et al. teaches away from the present  
24 invention, a fact that must be considered in determining obviousness, as  
25 was decided in General Tire and Rubber Co. v. Firestone Tire and Rubber  
26 Co., 174 USPQ at 445, where the Court held:

27 "In assessing the prior  
28 art, the Court must have  
29 regard for all of the  
30 signposts contained in  
31 it. It must consider  
32 the passages and  
33 references which point  
34 away from the invention  
35 as well as those said to  
36 point toward it..."  
37 [Emphasis added]"

1 To properly apply the decisional law of General Tire and Rubber Co.  
2 v. Firestone Tire and Rubber Co., one must first define what is considered  
3 "teaching away." The definition of "teaching away" was succinctly  
4 expressed in United States v. Adams, 383 U.S. 39, 52, 148 USPQ 479,484, 15  
5 L.Ed.2D 572, 86 S.Ct. 708 (1966); and W.L. Gore & Assoc., v. Garlock,  
6 Inc., 721 F.2d 1540, 1550-51, 220 USPQ 303, 311 (Fed. Cir. 1983), cert.  
7 denied, 469 U.S. 851 (1984), where the Court held:

8 "a reference teaches  
9 away if it suggests that  
10 the line of development  
11 flowing from the  
12 reference's disclosure  
13 is unlikely to be  
14 productive of the result  
15 sought by the  
16 applicant." [Emphasis  
17 added]

18 The connection between the load balancer and the server of Brendel  
19 et al. being through a discrete and/or distinct and/or dedicated  
20 connection that is independent of the Internet results in the servers not  
21 being able to be located anywhere in the world regardless of where in the  
22 world the load balancer is located and is therefore non-productive in  
23 producing the connection between the main server and the at least one  
24 participant server of the present invention being through the Internet  
25 which results in the at least one participant server being able to be  
26 located anywhere in the world regardless of where in the world the main  
27 server is located. Therefore, pursuant to W.L. Gore & Assoc., v. Garlock,  
28 Inc. discussed supra, Brendel et al. teach away from the present  
29 invention.

30 The information downloaded from the load balancer to the server of  
31 Brendel et al. being the browser's stored ACK packet would require costly  
32 multicasting if the servers other than that containing the load balancer  
33 did not contain the requested information and would therefore be non-  
34 productive in producing the information downloaded from the main server to

1 the at least one participant server of the present invention that is the  
2 requested information and therefore would not require costly multicasting  
3 if the at least one participant server does not contain the requested  
4 information. Therefore, pursuant to W.L. Gore & Assoc., v. Garlock, Inc.  
5 discussed supra, Brendel et al. again teach away from the present  
6 invention.

7 Brendel et al. would therefore lead a reader in a path divergent  
8 from the path that was taken by appellant and therefore "teaches away"  
9 from the present invention and can not be used to create a prima facie  
10 case of obviousness, as was decided in In re Gurley, 27 F.3d 551, 31, 31  
11 USPQ.2d at 1130 (Fed. Cir. 1994), where the Court held:

12 "a reference may be said  
13 to teach away when a  
14 person of ordinary  
15 skill, upon reading the  
16 reference would be led  
17 in a direction divergent  
18 from the path that was  
19 taken by the applicant  
20 ...a reference that  
21 "teaches away" can not  
22 create a prima facie  
23 case of obviousness."  
24 [Emphasis added]

25 The signposts of Brendel et al. that teach away from the present  
26 invention must be considered in creating a holding of obviousness, as  
27 required by General Tire and Rubber Co. v. Firestone Tire and Rubber Co.,  
28 United States v. Adams, W.L. Gore & Assoc., v. Garlock, Inc., and In re  
29 Gurley discussed supra which when analyzed will clearly indicate that the  
30 Examiner's combination is improper.

31 Appellant has provided clear and convincing evidence that neither  
32 Brendel et al., Bell et al., nor for that matter any of the references  
33 cited by the Examiner, accomplish appellant's result of providing an  
34 efficient Internet system that, inter alia:

1 1. Enables the at least one participant server to be located anywhere  
2 in the world regardless of where in the world the main server is  
3 located.

4 2. Eliminates a need for costly multicasting if the at least one  
5 participant server does not contain the requested information.

6 Therefore a holding of obviousness cannot be made out, as was  
7 decided by the Board of Appeals in Ex parte Tanaka, Marushima and  
8 Takahashi, 174 USPQ 38, where the Board held:

9 "Claims are not rejected  
10 on the ground that it  
11 would be obvious to one  
12 of ordinary skill in the  
13 art if the prior art  
14 devices do not  
15 accomplish applicant's  
16 result."[Emphasis added]

17 And, in In re Wright, 122 USPQ 522 (1959), where the Court held:

18 "...the mere aggregation  
19 of old elements that did  
20 not perform a different  
21 function is not a  
22 patentable invention,  
23 but that a novel  
24 combination of old  
25 elements which cooperate  
26 with each other to  
27 produce a new or useful  
28 result or a substantial  
29 increase in efficiency  
30 is patentable."[Emphasis  
31 added]

32 And, further in the en banc decision in In re Dillon, 919 F.2d 688,  
33 692 (Fed. Cir. 1990), where the Court held:

34 "...a prima facie case  
35 of obviousness requires  
36 that the prior art  
37 suggest the claimed  
38 compositions' properties  
39 and the problem the

1                    applicant attempts to  
2                    solve."[Emphasis added]

3            In this same regard, the Examiner's attention is respectfully  
4            directed to the decisions in In re Halleck, 164 USPQ 647 (CCPA 1970); and  
5            Kockum Industries, Inc. v. Salem Equipment, Inc., 175 USPQ 81 (9th Cir.  
6            1972).

7            In light of, inter alia In re Deuel, Richardson-Vicks Inc. v. The  
8            Upjohn Co., the Graham v. John Deere Co. test in light of, inter alia MPEP  
9            706.02, In re Jones, Arkie Lures, Inc. v. Gene Larew Tackle, Inc., Gambro  
10           Lundia AB v. Baxter Healthcare Corporation, In re Fritch, Heidelberger  
11           Druckmaschinen AG v. Hantscho Commercial Products, Inc., In re Fine, In re  
12           Keller, and In re Merck & Co., Inc., In re Kamm and Young, In re Stephens,  
13           Wenzl, and Browne, Panduit Corp. v. Burndy Corporation et al., Monarch  
14           Knitting Mach. Corp. v. Sulzer Morat GmbH, In re Rouffet, In re Miller, In  
15           re Fuetterer, In re Ludke and Sloan, In re Chu, Schnell et al. v. The  
16           Allbright-Nell Company et al., Ex parte Grasenick and Gessner, Mercantile  
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18           Irani and Moedritzer, General Tire and Rubber Co. v. Firestone Tire and  
19           Rubber Co., United States v. Adams, W.L. Gore & Assoc. v. Garlock, Inc.,  
20           In re Gurley, Ex parte Tanaka, Marushima and Takahashi, In re Wright, In  
21           re Dillon, In re Halleck, and Kockum Industries, Inc. v. Salem Equipment,  
22           Inc. discussed supra, pursuant to In re Fritch discussed supra appellant  
23           attacks the Examiner's prima facie determination as being improperly made  
24           out and tending to support a conclusion of nonobviousness.

25           In view of the arguments presented supra, appellant respectfully  
26           submits that the Examiner's grounds for the Examiner's rejection of claims  
27           1 and 4 under 35 U.S.C. 103(a) over Brendel et al. in view of Bell et al.  
28           are no longer tenable and appellant therefore respectfully requests that  
29           the rejection be reversed.

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ISSUE II

2

Whether claim 2 is anticipated under 35 U.S.C. 102(e) by Bell et al.

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Appellant respectfully submits that it is well settled that a dependent claim must be considered in determining patentability as including the limitations of the claim(s) from which it depends, as was supported in In re Schutte, 244 F.2d 323, 327 (CCPA 1957), where the Court held:

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"a dependent claim must  
be read as including the  
limitations of the claim  
from which it depends."  
[Emphasis added]

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Claim 2 depends from claim 1 and therefore includes all of the limitations of claim 1. Appellant is in a quandary as to how claim 2 can be rejected under 35 U.S.C. 102 when claim 2 depends from claim 1 which is rejected under 35 U.S.C. 103. Accordingly, appellant cannot address this issue, submits herewith a memorandum of law in opposition thereto, and absent correction will petition the Commissioner.

19

ISSUE III

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21

Whether claims 3, 5, and 6 are anticipated under 35 U.S.C. 102(a) by Brendel et al.

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Claim 3 depends from claims 1 and 2 and therefore includes all of the limitations of claims 1 and 2 and claims 5 and 6 depend from claim 4 and therefore includes all of the limitations of claim 4. Again, appellant is in a quandary as to how claim 3 can be rejected under 35 U.S.C. 102 when claim 3 ultimately depends from claim 1 which is rejected under 35 U.S.C. 103 and as to how claims 5 and 6 can be rejected under 35



1 U.S.C. 102 when claims 5 and 6 depend from claim 4 which is rejected under  
2 35 U.S.C. 103. Accordingly, again appellant cannot address this issue,  
3 submits herewith the memorandum of law in opposition thereto, and again  
4 absent correction will petition the Commissioner.

1

## CONCLUSION

2           Appellant respectfully submits for the Board's consideration that  
3 even if a valid combination could be made, which appellant does not  
4 contend as discussed in the argument section supra, since neither Brendel  
5 et al., Bell et al., nor for that matter any of the references cited by  
6 the Examiner, taken singularly teaches "...said main server...requesting  
7 over the Internet that said at least one participant server send the  
8 requested information over the Internet back to the client..."[claim  
9 1][Emphasis added], "...if said at least one participant server does not  
10 have the requested information, the requested information is downloaded  
11 from said main server to said at least one participant server..."[claim  
12 1][Emphasis added], "requesting over the Internet, by said main server  
13 acting like an orchestra leader, that said at least one nearest  
14 participant server send the requested information over the Internet back  
15 to the client..."[claim 4][Emphasis added], and "downloading the requested  
16 information from said main server to said at least one nearest participant  
17 server..."[claim 4][Emphasis added], any hypothetical combination thereof  
18 would not lead to appellant's invention.

1

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4		20, 39
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15	USPQ.2d 1977 (Fed. Cir. 1998) . . . . .	23, 39
16	MPEP 706.02 . . . . .	15, 39
17	Panduit Corp. v. Burndy Corporation et al., 180 USPQ 498 (District Court,	
18	N.D. Illinois, E. Div.) . . . . .	22, 39
19	Richardson-Vicks Inc. v. The Upjohn Co., 122 F.3d 1476, 44 USPQ.2d 1181	
20	(Fed. Cir. 1997) . . . . .	14, 39
21	Schnell et al. v. The Allbright-Nell Company et al., 146 USPQ 322 (Court	
22	of Appeals, Seventh Circuit 1965) . . . . .	31, 39
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24	86 S.Ct. 708 (1966) . . . . .	36, 37, 39
25	W.L. Gore & Assoc., v. Garlock, Inc., 721 F.2d 1540, 1550-51, 220 USPQ	
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1

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3 U.S. Patent Number 5,923,854 to Bell et al.

APPENDIX

1

2     1.    An Internet system, comprising:

3           a)    a main server for storing information to be requested over the  
4                Internet by a client so as to form a request for information  
5                and having an IP address; and

6           b)    at least one participant server having an IP address and  
7                electrically communicating with said main server; said at  
8                least one participant server not receiving the request for  
9                information from the client, but rather said main server  
10               receiving the request for information over the Internet from  
11               the client and requesting over the Internet that said at least  
12               one participant server send the requested information over the  
13               Internet back to the client, and if said at least one  
14               participant server does not have the requested information,  
15               the requested information is downloaded from said main server  
16               to said at least one participant server, and when said at  
17               least one participant server sends the requested information  
18               over the Internet back to the client, said at least one  
19               participant server assigns to the requested information said  
20               IP address of said main server and not said IP address of said  
21               at least one participant server.

22     2.    The system as defined in claim 1, wherein said main server is a  
23            TCP/IP server and assign jobs to said at least one participant  
24            server dynamically without relocating the client using neither HTTP  
25            nor HTML commands so as to take relocating process away from top  
26            networking OSI layers to 3rd level of Internet working OSI that is  
27            IP so as to enable starting downloading of the requested information  
28            from one of said at least one participant servers and finishing the  
29            downloading from another of said at least one participant server

1 without ever noticing server alteration by virtue of said at least  
2 one participant server assigning to the requested information said  
3 IP address of said main server and not said IP address of said at  
4 least one participant server.

5 3. The system as defined in claim 2, wherein said top networking OSI is  
6 at least one of TCP, HTTP, and application level.

7 4. A method for using an Internet system, comprising the steps of:  
8 a) making a request for information, over the Internet, by a  
9 client, to a main server of the Internet system and not to  
10 said at least one participant server;  
11 b) examining an IP address of the client, by said main server;  
12 c) seeking at least one participant server of the Internet  
13 system, by said main server, so as to form an at least one  
14 nearest participant server;  
15 d) requesting over the Internet, by said main server acting like  
16 an orchestra leader, that said at least one nearest  
17 participant server send the requested information to the  
18 client, packet-by-packet, over the Internet;  
19 e) determining if said at least one nearest participant server  
20 has the requested information;  
21 f) labeling, by said at least one nearest participant server,  
22 each packet with an IP address of said main server, which  
23 enables the client which has a port open only for main server  
24 addresses to accept said packets, if answer to step e) is yes;  
25 g) sending the requested information with said IP address of said  
26 main server, by said at least one nearest participant server,  
27 to the client, over the Internet;  
28 h) downloading the requested information from said main server to  
29 said at least one nearest participant server, which will

1 distribute the load of said main server to said at least one  
2 participant server when lacking multicasting so as to save  
3 costs, by virtue of said at least one participant server being  
4 relatively easy and inexpensive to add as compared to  
5 clustering more servers to said main server, if answer to STEP  
6 5 is no; and

7 i) returning to step f).

8 5. The method as defined in claim 4, wherein said step of making a  
9 request for information, over the Internet, by the client, from the  
10 main server includes making the request for at least one of a  
11 streaming video and an audio, over the Internet, by the client, from  
12 the main server.

13 6. The method as defined in claim 4, wherein said step of seeking the  
14 nearest at least one participant server, by said main server, so as  
15 to form an at least one nearest participant server includes seeking  
16 the nearest at least one nearest participant server, by said main  
17 server, so as to form said at least one nearest participant server  
18 that has the most bandwidth and CPU and other serving requirements  
19 needed to furnish the requested information to the client.





1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
2 BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

3 Applicant: Gorkam I. Ates

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Filed: September 22, 1999

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Paper No.: 13

6 Invention: INTERNET SYSTEM

7 Examiner: Hai V. Nguyen

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8 As article No.: EL586861493US EXPRESS MAIL I hereby certify, that on the  
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14 Assistant Commissioner

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16 Washington, D.C. 20231

BY: [Signature]  
Agent for Appellant

Date: Feb. 10, 2003

17 MEMORANDUM OF LAW IN SUPPORT OF APPELLANT'S BRIEF

18 Appellant submits the instant Memorandum Of Law in triplicate in  
19 support of its Brief on appeal.

Paper No.: 13

S.N.: 09/401,221

Agt. Doc. No.: ATEG21A

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POINT II

IN ORDER FOR A REJECTION  
UNDER 35 U.S.C. 102 TO  
BE VALID EACH AND EVERY  
LIMITATION MUST BE MET  
BY A SINGLE REFERENCE

7           Anticipation under 102 requires identity of invention. The claimed  
8 invention, including each element thereof as described in appropriately  
9 construed claims, must have been disclosed in a single reference. To  
10 anticipate a claim, a prior art reference must disclose every limitation  
11 of the claim. Scripps Clinic & Research Found. v. Genentech Inc., 927  
12 F.2d 1565, 1576, 18 USPQ.2d 1001, 1010 (Fed. Cir. 1991); In re Schreiber,  
13 128 F.3d 1473, 44 USPQ.2d 1429 (Fed. Cir. 1997); Elmer v. ICC Fabricating,  
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20 15 USPQ.2d 1655, 1657 (Fed. Cir. 1990).

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POINT III

FOR A REFERENCE TO  
DISCLOSE EACH AND EVERY  
ELEMENT OF A CLAIM, IT  
MUST DISCLOSE IT WITH  
SUFFICIENT CLARITY TO  
PROVE ITS EXISTENCE

28           For a prior art reference to anticipate a claim, the reference must  
29 disclose each and every element of the claim with sufficient clarity to  
30 prove its existence in the prior art. That presumed knowledge, however,  
31 did not grant a license to read into the prior art reference teachings

1 that were not there. Motorola, Inc. v. Interdigital Technology  
2 Corporation, 121 F.3d 1461, 43 USPQ.2d 1481 (Fed. Cir. 1997).

3 POINT IV

4 WHEN ISSUING A 102  
5 REJECTION ALL OF THE  
6 SAME ELEMENTS MUST BE  
7 FOUND IN EXACTLY THE  
8 SAME SITUATION AND  
9 UNITED IN THE SAME WAY  
10 TO PERFORM THE IDENTICAL  
11 FUNCTION IN THE PRIOR  
12 ART PATENT

13 Anticipation is strictly a technical defense. Unless all of the  
14 same elements are found in exactly the same situation and united in the  
15 same way to perform the identical function in a prior pleaded patent,  
16 there is no anticipation. Stauffer v. Slenderella Systems of California,  
17 254 F.2d 127, 128, 115 USPQ 347, 348-349 (9th Cir. 1957); National Lead  
18 Company v. Western Lead Products Company, 324 F.2d 539, 544, 139 USPQ 324,  
19 327-328 (9th Cir. 1963); and Kockum Industries, Inc. v. Salem Equipment,  
20 Inc., et al., 175 USPQ 81 (Court of Appeals, Ninth Circuit 1972).

21 CONCLUSION

22 A claim cannot be rejected under 35 U.S.C. 102 if it depends from a  
23 claim rejected under 35 U.S.C. 103 because in order for a rejection under  
24 35 U.S.C. 102 to be valid each and every limitation must be met by a  
25 single reference with sufficient clarity to prove their existence so that  
26 all of the same elements are found in exactly the same situation and  
27 united in the same way to perform the identical function.

28 Therefore, claim 2 cannot be rejected under 35 U.S.C. 102 because it  
29 depends from claim 1 which is rejected under 35 U.S.C. 103, claim 3 cannot

1 be rejected under 35 U.S.C. 102 because it ultimately depends from claim  
2 1 which is rejected under 37 CFR 103, and claims 5 and 6 cannot be  
3 rejected under 35 U.S.C. 102 because they depend from claim 4 which is  
4 rejected under 35 U.S.C. 103.

1

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